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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,182	08/02/2001	Gregory Maurice Plow	STL920000035US1	7553

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ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/922,182	PLOW ET AL.
	Examiner	**Art Unit**	
	James W. Myhre	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 July 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11 and 13-19* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-11, and 13-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the Response to Office Action filed on July

13, 2007. Claims 1-4, 6-11, and 13-19 are currently pending and have been considered

below.

EXAMINER'S NOTE

2.   In Claims 7-11 and 13-19 the Applicant appears to be attempting to invoke 35

U.S.C. 112, 6th paragraph through the use of means-plus-function language, e.g. "logic

mean for enabling a user to select a saved advertisement..." (Claim 7). The test of

successful invocation of this paragraph comprises three prongs – (1) proper means-

plus-function language in the claim; (2) no structural limitation in the claim; and (3)

explicit structural limitations recited within the specification. While the language in these

claims successfully passes the first prong of the three-prong test, it does not pass either

of the other two prongs of the test. The claims themselves describe "logic means" as

being part of a computer program, thus eliminating any kind of physical structure.

Likewise, the specification describes the means for performing these functions as part

of a computer program. Thus, no physical structure has been identified to which these

functions could be attributed. Therefore, 35 U.S.C. 112, 6th paragraph has not been

successfully invoked and the Examiner will consider the limitations to be any means by

which the functions can be accomplished, e.g. computer program modules.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-4, 6-11, and 13-19 are rejected under 35 U.S.C. 102(b) as being

anticipated by LeMole et al(6,009,410).

Claims 1, 7, 8, 14, and 18: LeMole discloses a system, computer readable medium,

and method for storing Internet advertisements at a user computer, comprising:

        a. receiving automatically (pushed) a plurality of Internet advertisement at the

user computer (column 6, lines 20-45);

        b. saving (storing) the plurality of advertisements on the user computer (column

6, lines 20-45);

        c. accessing the saved plurality of advertisements by the user on the display (i.e.

advertising history window) of the user computer (column 5, lines 23-27;

        d. filtering previously displayed advertisements to determine eligible

advertisements (column 5, lines 16-22);

        e. selecting one of the advertisement by the user (column 6, lines 63-66); and

        f. accessing the advertiser's website by clicking on a link within the

advertisement (column 4, lines 29-35 and column 7, lines 12-35).

Claims 2, 9, and 15: <u>LeMole</u> discloses a system, computer readable medium, and

method as in Claims 1, 7, and 14 above, and further discloses the advertisement

including an HTML tag (column 4, lines 29-35 and column 7, lines 12-35).

Claims 3, 10, and 16: <u>LeMole</u> discloses a system, computer readable medium, and

method as in Claims 1, 8, and 14 above, and further discloses displaying the

advertisement in response to toggling (clicking on) a button (Figure 2 and column 7,

lines 12-35).

Claims 4, 11, and 17: <u>LeMole</u> discloses a system, computer readable medium, and

method as in Claims 3, 10, and 16 above, and further discloses allowing the user to

scroll through the advertisements (Figure 2 – top right corner of screen depicts the scroll

bar that can be used to scroll through any data displayed in the window).

Claims 6, 13, and 19: <u>LeMole</u> discloses a system, computer readable medium, and

method as in Claims 1, 8, and 14 above, and further discloses displaying and using

Previous (Back) and Next (Forward) buttons to navigate through the saved

advertisements or any other data/pages being displayed in the window (Figure 2 and

column 6, line 63 – column 7, line 35).

Response to Arguments

5.   Applicant's arguments with respect to claims 1, 4, 6, 7, and 13 have been fully

considered but they are not persuasive.

        a. The Applicant argues in reference to Claim 1 that LeMole does not disclose

"an advertising history window displaying Internet content composed of plural

advertisements" (paragraph 1), nor that the advertisements "are saved at the user

computer" (paragraph 1). However, the Examiner notes that LeMole expressly

discloses the user viewing "a composite HTTL-formatted advertising page" and that "a

plurality of different composite pages for the user...are each pushed over the Internet to

the user's client terminal where each is cached for later retrieval".

        b. The Applicant also argues in reference to Claim 1 that LeMole does not

disclose "the limitation of allowing a user to filter previously displayed advertisements"

(paragraph 2). However, the Examiner notes that LeMole discloses that the

advertisements will be filtered (selected) based on the user data which the user had

entered when registering with the system, i.e. the advertisements are being filtered by

the user.

        c. The Applicant argues in reference to Claim 4 that LeMole does not disclose

allowing the "user to scroll through the saved advertisements" (paragraph 3). However,

as noted in the rejection above, LeMole discloses a scroll bar on the display window

and further discloses the window containing a plurality of previously viewed

advertisements (advertising history window). Thus, it is inherent that the scroll bar

would be used to scroll through any data, including advertisements, being displayed

within the window.

d. The Applicant argues in reference to Claim 6 that LeMole does not disclose

"using back and forward buttons to navigate through the saved advertisements"

(paragraph 4). However, as noted in the rejection above, LeMole discloses Back and

Forward buttons for navigating through the data being displayed on the display window

and further discloses the window containing a plurality of previously viewed

advertisements (advertising history window). Thus, it is inherent that the Back and

Forward buttons would be used to navigate between the advertisements and between

the different composite advertising windows discussed by LeMole.

e. The Applicant argues in reference to Claim 7 that LeMole does not disclose

that "the server transmit the Internet advertisements to the user computer while the user

is engaged in activity other than requesting the advertisements" (paragraph 5). The

Examiner notes that LeMole discloses that the advertisements are automatically

"pushed" to the user's computer before the user enters the commercial mode. Thus,·

the server is transmitting the advertisements to the user computer while the user is not

actively requesting the advertisements.

f. The Applicant argues in reference to Claim 13 that the above argues also

apply ("*mutatis mutandis*")(paragraph 6). The Examiner notes that the above responses

to the Applicant's arguments also apply to Claim 13.

g. Finally, the Applicant argues that Claims 7-11 and 13-19 invoke 35 U.S.C. 6th

paragraph by citing specific structure in the specification for each of the means-plus-

function limitations in the claims (paragraph 7). However, the Applicant has failed to

point out any specific structures within the specification that define any of the mean-

plus-function limitations. "Logic means", i.e. computer programming code, is not a

physical structure, contrary to the Applicant's arguments. In fact, in Claim 7 it is

expressly recited that "the program further comprises:" the logic means. Thus, even in

the claims the Applicant has admitted that the means are not physical structures, but

merely computer programming code.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James W. Myhre whose telephone number is (571) 272-

6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
August 3, 2007

James w. Myhre
Primary Patent Examiner